Please enter the following amendments and remarks:

STATUS OF THE CLAIMS

Claims 1, 4-9, 12-16, 24, 28, 31-33 and 55-65 are pending in the Application.

Claims 1, 4-9, 12-16, 24, 28, 31-33 and 55 have been rejected by the Examiner.

Reconsideration of the present Application is respectfully requested.

REMARKS

Claims 1, 4-9, 12-16, 24, 28 and 31-33 have been rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 1, 4-8, 14-16 and 31-33 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Weiner in view of Assisi (U.S. Patent No. 5,696,488). Claims 9, 12-13, 24, 28 and 55 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Weiner (EP 380 727). Applicant respectfully traverses these rejections for at least the following reasons.

Claim Rejections Pursuant to 35 U.S.C. 112, Second Paragraph

Claims 1, 4-9, 12-16, 24, 28 and 31-33 have been rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Applicant respectfully traverses these rejections for at least the following reasons.

35 U.S.C. 112, second paragraph, states:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

The present office action rejects Claim 1, specifically referencing the portion of the claim which states "wherein data corresponding to the memorial information

is stored internally within the memory device, and wherein the memory device is free from physical connection to a source of data, while the memory device is positioned at the cemetery location." *Office Action @ 3.* The present office action represents that this phrase is unclear as to what is the source of the data. Further, the Office Action posits the questions "Is applicant referring the power source as the source of the data?" Similarly, the present office action rejects Claims 9, 24 and 28. Further, Claims 2 – 8, 10 – 16 and 29 – 33 are referenced as vague and indefinite as depending from the claims rejected above.

Applicant has amended Claim 1 to more distinctly point out and claim the present invention. In this regard, amended Claim 1 recites, in part,

> wherein data corresponding to the memorial information is stored internally within the memory device, and wherein the memory device is free from physical connection to a source of the data at least while the memory device is positioned at the cemetery location, and wherein the memory device is free from an external physical connection to a power source at least while the memory device is positioned at the cemetery location.

Applicant respectfully submits that the present invention, as discussed in more detail herein below, operates at a remote location where delivery of data (and separately power) may be difficult, and therefore the memory device of the present invention may be required to accept data, and store this data for a non-fleeting period of time during which no further power or data are applied directly to the memory device. Under such conditions, the data, after the passage of time, is made available from the memory device to a portable memory reading device.

Applicant respectfully submits that, in addition to more distinctly pointing out and claiming what Applicant regards as the invention, this change also renders the rejection in the present office action overcome. Further, Applicant notes that Applicant is not required to claim the source of the data, but, responsive to Examiner's issue, the source of the data is taught in the specification as any data source capable of downloading, via a wired or wireless connection, data to a separate memory device, subject to the limitation of the present claims that the data source, after downloading the data to the memory device, must be disconnected from the memory device for a significant time period before the portable memory device reads the data from the memory device. Applicant thus respectfully submits that Amended Claim 1 satisfies 35 U.S.C. § 112.

Applicant has similarly amended Claims 9, 24 and 28, and further respectfully submits that the rejection based on 35 U.S.C. § 112 has been overcome with respect to those independent claims.

Claim Rejections Pursuant to 35 U.S.C. §103

Claims 1, 4-8, 14-16 and 31-33 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Weiner in view of Assisi (U.S. Patent No. 5,696,488). Claims 9, 12-13, 24, 28 and 55 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Weiner (EP 380 727). Applicant respectfully traverses these rejections for at least the following reasons.

35 U.S.C. §103(a) recites:

> [a] patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). *MPEP 706.02(j)*.

A. Claims 1, 4-9, 12-16, 24, 28, 31-33 and 55

Claims 9, 12-13, 24, 28 and 55 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Weiner (EP 380 727). Claims 1, 4-8, 14-16 and 31-33 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Weiner in

view of Assisi (U.S. Patent No. 5,696,488). Applicant respectfully traverses these rejections for at least the following reasons.

Amended Claim 1 states, in relevant part,

> wherein data corresponding to the memorial information is stored internally within the memory device, and **wherein the memory device is free from physical connection to a source of the data at least while the memory device is positioned at the cemetery location, and wherein the memory device is free from an external physical connection to a power source at least while the memory device is positioned at the cemetery location**

[Emphasis Added].

The present Office Action has attempted to combine the teachings of Assisi and Weiner to reject Claim 1. Applicant respectfully submits that the combination of Assisi and Weiner fail to teach a reading of the memory device by a portable user device, wherein the memory device is free from connections to power and data when read by the portable device. This fact has been pointed out numerous times in the communications between Applicant and the Patent Office. Each successive action has asked the questions as to the source of the data. Applicant respectfully submits that the source of the data is not recited or required in the present claims. The claims are directed to a system of loading data on a memory device, wherein the device in turn located at a particular remote location, and to a system of later accessing the data to a portable user device.

More specifically, when a user device is in proximity to this memory device, the data stored on the memory device is transferred to the user device in such a fashion that the user device can then communicate the information to the user while the user and user device are in proximity to the location. The memory device is substantially permanently located at the remote location and, is not provided with a connection for power or data after the transfer of data to the memory device aforementioned. The memory device is not provided with any information as to what data to transmit. Instead, when the user device is placed in proximity to the memory device, the memory device transfers the data previously saved therein to the user unit for display to the user.

As may be seen in Figure 2 of Weiner, when the sound producing unit of Weiner is placed in contact with the memory unit, energy is transferred to the memory unit. This is inapposite to the teaching and claims of the present invention. As recited above, **the memory device is free from an external physical connection to a power source at least while the memory device is positioned at the cemetery location**. Applicant has devised the present technique in order to place data at remote locations where power and data connection are limited or unavailable.

At least this shortcoming in the teaching of Weiner, a deficiency not filled by Assisi, nor asserted by the Examiner to be filled, causes Weiner to fail to render amended Claim 1 unpatentable. The present Office Action identifies Assisi for the proposition that memorial information about a deceased party may be provided, but

Assisi does not teach, nor is Assisi asserted to teach, the shortcoming in the teaching of Weiner identified hereinabove.

Weiner in view of Assisi thus fails to teach, at least, a memory device free of connections for power and data while the memory device is positioned at the remote location, and thus Weiner in view of Assisi does not render Claim 1 unpatentable. *See MPEP 2131.* Consequently, Applicant traverses the 35 U.S.C. §103(a) rejection of Claim 1, deems it overcome, and respectfully requests removal of the rejection. In addition, Applicant submits that independent Claim 1 is in a condition for allowance.

Applicant further submits that Weiner in view of Assisi fails to teach, and therefore anticipate or render unpatentable, Claims 2-8 because of these claims ultimate dependence on patentably distinct base Claim 1. Applicant submits that each of Claims 2-8 are similarly in a condition for allowance.

Independent Claims 9, 24, 28 and 55 similarly recite that a memory device, free of connections for power and data, is positioned at the remote location. In this regard, Applicant respectfully submits that Claims 9 and 28 are not rendered unpatentable by Weiner in view of Assisi, at least for the reasons set forth hereinabove with respect to Claim 1. Consequently, Applicant traverses the 35 U.S.C. §103(a) rejections of Claims 9, 24, 28 and 55, deems them overcome, and respectfully requests removal of these rejections. In addition, Applicant submits that independent Claims 9, 24 and 28 are in a condition for allowance.

Applicant further submits that Assisi in view of Lake fails to teach, and therefore anticipate or render unpatentable, Claims 10-16 and 29-33 because of these claims' ultimate dependence on patentably distinct base Claims 9 and 28, respectively. Applicant thus submits that each of Claims 10-16 and 29-33 are similarly in a condition for allowance.

C. Motivation and Reasonable Expectation of Success for Combining References for the § 103 Rejection

The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on an applicant's disclosure. *In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. 3*It is improper to combine references where the references teach away from their combination. *In re Grasselli 713 F.2d 731 (Fed. Cir. 1983).* More specifically, MPEP § 2143.01 states:

> Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. "The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art." *In re Kotzab, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000). See also In re Lee, 277 F.3d 1338, 1342-44, 61 USPQ2d 1430, 1433-34 (Fed. Cir. 2002)* (discussing the importance of relying on objective evidence and making specific factual findings with respect to the motivation to combine references); *In re Fine, 837 F.2d 1071, 5*

> *USPQ2d 1596 (Fed. Cir. 1988); In re Jones, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).*

Further, MPEP 2141.02

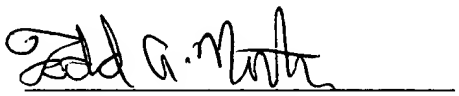
> A prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention. *W.L. Gore & Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984).*

Applicant respectfully submits that the combination of Weiner and Assisi is an impermissible combination of references. In particular, Weiner teaches the use of audible speech stored on a ROM and transfers at least power to the memory device when contacted by the sound-producing unit to be played while at the location. This is in direct contradiction to the teachings found in Assisi, wherein it is specifically set forth that a wireless connection is utilized and data may be stored to be reviewed or played at another location. These distinctions in the teaching of Assisi and Weiner prevent these patents from being combined, as each one teaches away from the other in at least the above-identified respects.

Conclusion

Applicant respectfully requests reconsideration of the present Application in light of the reasons set forth herein, and a Notice of Allowance for all pending claims is earnestly solicited.

Respectfully Submitted,



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